

("Thompson"). The Examiner additionally rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Skelton in view of Cowan and Thompson and further in view of Holcomb, et al., U.S. Patent No. 5,933,085 ("Holcomb"). Applicant's representative respectfully traverses the 35 U.S.C. 103(a) rejections of claims 1-7.

Applicant's representative would like to thank the Examiner for conducting an additional search and citing additional references. Obviously, the strength of any issued patent is partly determined by the quality and extent of the prior art search conducted during prosecution of the corresponding patent application. It is to Applicant's great benefit that all potential references are considered. The Examiner's attention to searching for potential references is greatly appreciated.

One embodiment of Applicant's invention is a single-sheet combined registration form and key packet that may be printed during registration of a hotel guest. The combined registration form and key packet may be printed on a laser printer by a hotel clerk after entering hotel guest information into a computerized registration system. The hotel clerk may then detach the registration form from the combined registration form and key packet. The registration form is signed by the hotel guest and returned to the hotel clerk, while the hotel clerk folds the key packet along perforated lines and inserts a hotel room key into the completed key packet. Finally, the hotel clerk provides the folded key packet including the hotel room key to the hotel guest.

Figure 2 illustrates a single-sheet, combined registration form and key packet blank. The blank includes a vertical line of perforations (202 in Figure 2) and two horizontal lines of perforations (204 and 210 in Figure 2). In addition, the blank includes, as illustrated in Figure 2, two die-cut slots (214 and 212 in Figure 2) for holding a metal key and a rectangular magnetic key card, respectively.

Independent claim 1 is directed to the single-sheet, combined registration form and key packet illustrated in Figure 2.

Claim 1 recites:

1. A single-sheet registration form and key packet comprising:
  - a registration form;
  - an unfolded key packet separated the registration form by a line of perforations, the unfolded key packet including a number of lines of perforations that allow the unfolded key

packet to be quickly and accurately folded into a complete key packet; and

one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys in the complete key packet.

Thus, Applicant's single-sheet registration form and key packet includes: (1) a registration form; (2) an unfolded key packet separated from the registration form by a line of perforations; and (3) one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys.

Skelton, Cowan, and Thompson disclose ticket envelopes, and Holcomb discloses an environmental control lock system. Neither Skelton, Cowan, Thompson, nor Holcomb disclose, teach, mention, or suggest a single-sheet registration form and key packet. In fact, neither Skelton, Cowan, Thompson, nor Holcomb disclose, mention, teach, or suggest a key packet of any type. As the Examiner is certainly aware, and as is discussed in detail in the MPEP § 2141.02, a claimed invention as a whole must be considered. Skelton, Cowan, and Thompson are designed as containers for tickets and boarding passes, while Applicant's claimed registration form and key packet are designed to include a detachable registration form and a key packet that includes die-cut slots for holding various types of room keys. Thus, Applicant's registration form and key packet includes different elements than the elements included in Skelton, Cowan, and Thompson, and is specifically designed to address a different problem than the problems addressed by Skelton, Cowan, and Thompson. In Applicant's representative's opinion, the Examiner's combination of Skelton, Cowan, and Thompson focuses on perceived similarities between certain unrelated elements of the cited references and Applicant's claimed invention without considering Applicant's claimed registration form and key packet as a whole.

Skelton and Cowan are single-sheet ticket envelopes. However, while Applicant's unfolded key packet can be "quickly and accurately folded into a complete key packet," Cowan's ticket envelope requires application of an adhesive during a manufacturing process: "Of course with such an arrangement, adhesive 42 would be applied to the outer face of flap 20" (Cowan, column 2, lines 50-52). Thompson is not a single-sheet ticket envelope, but is manufactured from separate pieces, including a die-cut blank (12 in Figure 2) and a sheet of material such as glassine (Thompson, 44 in Figure 2 and column 1, lines 63-69 and

column 2, lines 37-38). Like Cowan, Thompson's ticket envelope requires application of adhesive during a manufacturing process (e.g. Thompson, column 2, lines 39-44).

Both Skelton and Cowan completely lack "one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys in the complete key packet." The Examiner employs Thompson for disclosure of a key-containing slot, stating: "Thompson discloses an envelope having a slot (42) which is capable of retaining a key, key card, ticket, or the like" (Office Action, page 3, line 16). However, Thompson neither teaches, mentions, nor suggests retention of keys in the slot cited by the Examiner. Significantly, the elongated opening or slot 42 is an opening into a second pocket formed between rear panel 16 and the sheet of material 44 (Thompson, column 2, lines 33-39). Thompson's second pocket is designed to hold a boarding pass within the second pocket: "Thus, *a separate pocket is provided within a ticket pocket for the reception and retention of baggage claim checks or other accessory stubs*" (Thompson, column 2, lines 72-74, emphasis added). Thompson's elongated opening or slot does not hold the boarding pass, but merely serves as an opening into a manufactured pocket, which holds the boarding pass. Therefore, not only does Thompson fail to disclose, teach, mention, or suggest die-cut slots, which serve to hold various types of keys within a key packet, Thompson's elongated opening and second pocket are structurally dissimilar from Applicant's die-cut key-holding slots. The dimensions of the elongated slot and of a boarding pass are not specified in Thompson. *There is therefore no basis for the Examiner to conclude that Thompson's slot is capable of retaining a key. It was neither designed to retain a key, nor designed to retain anything else.*

The Examiner states, in section 5 of the Office Action dated April 27, 2001, that "[r]egarding Applicant's argument that Holcomb does not disclose a key packet or envelope for containing a keycard, Holcomb is solely used for teaching of a magnetic keycard and has not been relied upon for teaching of a key packet or envelope." Applicant's representative wishes to respectfully remind the Examiner that "[t]he mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of a combination." (MPEP § 2143.01). Applicant is not claiming a magnet keycard. Applicant is instead claiming a single-sheet registration form and key packet that conveniently folds various types of keys, including magnetic keycards. Holcomb is non-analogous art, and contains no teaching, mention, or suggestion of containers

for magnetic keycards of any kind. The combination of three different types of ticket envelopes, including a ticket envelope with a paper/glassine pocket for holding a boarding pass, and an environmental lock that employs a magnetic keycard does not, in combination, make obvious a single-sheet registration form and key packet with a die-cut slot specifically designed to contain a magnetic keycard. *Specifically, there is no suggestion in any of the cited references for containing anything within a die-cut slot, and there is certainly therefore no teaching or suggestion within the cited references for combining a magnetic card key with a slotted container.*

According to MPEP § 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner has failed to establish a *prima facie* case of obviousness. There is no suggestion or motivation in the cited references for any application or implementation related to a single-sheet registration form and key packet. Second, as noted above, the cited references fail to teach or suggest a key packet for containing keys, and fail to teach or suggest die-cut slots in an unfolded key packet which serve as a slot or slots for a number of keys. As noted above, Thompson's elongated opening and second pocket is not only intended for a purpose other than retaining objects, but it is structurally quite dissimilar from Applicant's die-cut slots for holding keys. No combination of Skelton, Cowan, Thompson, and Holcomb produces Applicant's claimed single-sheet registration form and key packet.

In MPEP § 2141, a standard of patentability that arose in the Supreme Court case *Graham v. John Deere*, 283 U.S. 1, 148 USPQ 459 (1966) is provided in detail. This *Graham* standard includes secondary considerations such as commercial success, long felt but unsolved needs, failures of others, etc. While the current application is directed toward a relatively simple and straightforward invention, there are a number of such secondary considerations that would argue strongly against an obviousness-type rejection. First, the Applicant has, in the year following filing of the application, built a significant business

manufacturing and selling the single-sheet registration form and key packet that is the subject of the current application. The Applicant is selling the single-sheet registration form and key packets to major hotel chains, including Hilton Hotels, which have recognized efficiencies and economies in using Applicant's invention during registration of hotel guests. No such single-sheet registration form and key packet was available prior to Applicant's entry into this field, and Applicant's clients have responded to Applicant's product enthusiastically. Second, Applicant has received notice from several print shops that the print shops have been contacted by third parties to produce single-sheet registration form and key packets as disclosed in the current application, but without the patent pending status included by Applicant on his products. While perhaps a simple invention, Applicant's invention is nevertheless important to Applicant, is extremely well regarded in the hotel industry, and is already a target for copying by Applicant's competitors.

Thus, in summary, no cited reference teaches, mentions, or suggests retention of a key of any type within a die-cut slot, and therefore, Applicant's "one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys in the complete key packet" is not obvious in view of any cited reference or in view of any combination of cited references. While Applicant's invention is directed to a single-sheet key packet and detachable registration form that can be easily produced from a pre-printed blank by folding, the cited references are, by contrast, directed to ticket holders, two requiring application of adhesive during a manufacturing process, and none directed to combination of a registration form and key packet in a single sheet.

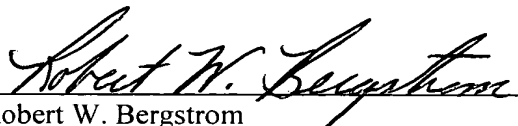


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All of the claims remaining in the application are now clearly allowable.  
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,  
Ted Eugene Wright  
Summit Law Group, PLLC

  
Robert W. Bergstrom  
Registration No. 39,906

Enclosures:  
Postcard  
Form PTO-1083 (+ copy)

Summit Law Group  
1505 Westlake Ave. N., Ste. 300  
Seattle, Washington 98109  
Phone: (206) 281-9881  
Fax: (206) 281-9882

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